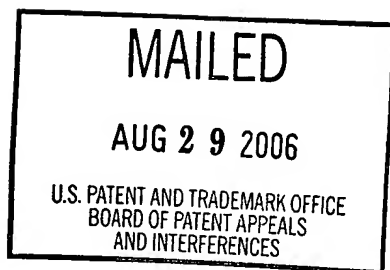


The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**



Ex parte RUSSELL WARNER

Appeal No. 2006-1748
Application No. 10/728,375

ON BRIEF

Before FRANKFORT, CRAWFORD, and FETTING, Administrative Patent Judges.
CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 1 to 9, 12, 14
and 15, which are all of the claims pending in this application. Claims 10, 11, and 13
have been cancelled.

The appellant's invention relates to a device for opening a stiff or frozen door (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

THE PRIOR ART

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Moses	D164,705	Oct. 2, 1951
Sutton	4,788,893	Dec. 6, 1988
Thomas et al. (Thomas)	5,337,632	Aug. 16, 1994
Waddell	D442,840	May 29, 2001
Crowley	6,799,491	Oct. 5, 2004

THE REJECTIONS

Claims 1 to 8, 12, 14 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sutton in view of Thomas.

Claim 9 stands rejected under 35 U.S.C. § 103 as being unpatentable over Sutton and Thomas and further in view of Crowley, Moses or Waddell.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the non-final rejection (mailed February 8, 2005) and the answer (mailed August 22, 2005) for the examiner's complete reasoning in support of the rejections, and to the brief (filed May 19, 2005) and reply brief (filed November 21, 2005) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

We turn first to the examiner's rejection of claims 1 to 8, 12, 14 and 15 under 35 U.S.C. § 103 as being unpatentable over Sutton in view of Thomas. We initially note that the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

The examiner's findings in regard to the teachings of Sutton can be found on page 2 of the non-final rejection mailed on February 8, 2005. The examiner relies on Thomas for teaching an angled device having a constant width and concludes:

It would have been obvious to one of ordinary skill in the art, given the teaching of Sutton in col. 2, lines 60-64, to provide a constant width to the Sutton device as taught by Thomas et al as an obvious matter of design choice in enhancing the strength of the prying device [non-final rejection mailed February 8, 2005, pages 2 to 3].

The examiner considers the language in claim 1 regarding the use of the device to open a frozen or stiff seal, to be language of intended use which does not accord patentable weight to the claims.

Appellant argues that Sutton's device is meant to be placed under the door handle and then lifted upwardly so as to assist in opening the door handle whereas the present invention is meant to be placed between the car door and door frame and levered by the user or pulled.

We do not find this argument persuasive because we agree with the examiner that this language pertains to the intended use of the device. It is well established that the manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself. In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967). A statement of intended use does not qualify or distinguish the structural apparatus claimed over the reference. In re Sinex, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962). There is an extensive body of precedent on the question of whether a statement in a claim of purpose or intended use constitutes a limitation for purposes of patentability. See generally Kropa v. Robie, 187 F.2d 150, 155-59, 88 USPQ 478, 483-87 (CCPA 1951) and the authority cited therein, and cases compiled in 2 Chisum, Patents § 8.06[1][d] (1991). Such statements often, although not necessarily, appear in the claim's preamble. In re Stencel, 828 F.2d 751, 754, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987).

Appellant also argues that neither Sutton nor Thomas describe a device having a constant width along the entire length of the device.

We do not find this argument persuasive because Sutton discloses that it is well within the skill of the artisan to change dimensions and shapes of the various embodiments (col. 2, lines 60 to 64). Such disclosure would have suggested to a person of ordinary skill in the art that the shape of the device could be changed to meet the design desires of the artisan. In addition, we agree with the examiner that Thomas discloses a device having a constant width along the length of the device as broadly claimed.

Appellant also argues that neither reference describes a device that has first and second plate portions of substantially equal lengths.

We do not find this argument persuasive because we agree with the examiner that Sutton discloses a device having first and second plate portions of substantially equal lengths at least to the extent that appellant discloses a device having first and second plate portions of substantially equal lengths. In this regard we note that the device depicted in Figure 2 of Sutton includes first and second plate portions having substantially equal lengths to the extent that the device disclosed in Figures 1 and 3 of appellant's disclosure depicts a device having first and second plate portions having substantially equal lengths.

Appellant also argues that the Sutton device is limited to a device having first and second plate portions disposed at a 45 degree angle and thus does not meet the recitation in claim 1 that the device having first and second plate portions have a spaced relation so that they are disposed from 45 degrees to 85 degrees apart.¹

We do not agree with the appellant that the Sutton device is limited to plates disposed at a 45 degree angle because as we discussed above, Sutton discloses that the device disclosed can be changed so as to have different dimensions and shapes. In addition, Sutton's Figure 10, appears to depict a device having first and second plate portions disposed at an angle greater than 45 degrees. As such, Sutton suggests a device having first and second plate portions disposed at an angle greater than 45 degrees. In any case, the disclosure in Sutton of a device having plates disposed at a 45 degree angle is sufficient to meet the limitations in the claim because 45 degrees is included in the claimed range of 45 degrees to 85 degrees.

In view of the foregoing, we will sustain the examiner's rejection of claim 1. We will also sustain the examiner's rejection of claims 2 to 8, 12, 14 and 15 because the appellant has not argued the separate patentability of these claims. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987).

¹ We note that the claim language in claim 1 and claim 4 that the first and second plate portions are disposed to form a substantially right angle about a central point of from 45 to 85 degrees is unclear. An angle that is 45 to 85 degrees is not a right angle. As such, the claims on appeal do not appear to meet the requirements of 35 U.S.C. § 112, second paragraph.

We turn next to the examiner's rejection of claim 9 under 35 U.S.C. § 103 as being unpatentable over Sutton and Thomas and further in view of Crowley, Moses or Waddell. The examiner, recognizing that neither Sutton nor Thomas explicitly discloses first and second plate portions disposed at an angle between 65 and 85 degrees, relies on Crowley, Moses or Waddell for this teaching.

We agree with the examiner that as discussed above, Sutton suggest the modification of the device therein described. In addition, Figure 10 of Sutton is suggestive of a device having first and second plate portions disposed at an angle greater than 45 degrees. In addition, each of the references Crowley, Moses and Waddell discloses that a prying angle between 65 and 85 degrees is a known operative prying angle. As such, in our opinion, there is ample motivation to provide the device of Sutton with first and second plate portions disposed at an angle between 65 and 85 degrees.

Appellant argues that the devices of Crowley, Moses and Waddell are elongate devices that are too cumbersome to place on a key chain and that they do not have a constant width along the length of the device.

We do not find these arguments persuasive because all of the features of the secondary reference need not be bodily incorporated into the primary reference (see In re Keller, supra, at 642 F.2d 425, 208 USPQ 881) and the artisan is not compelled to blindly follow the teaching of one prior art reference over the other without the exercise

of independent judgment (see Lear Siegler, Inc. v. Aeroquip Corp., 733 F.2d 881, 889, 221 USPQ 1025, 1032 (Fed. Cir. 1984)). In this regard, Crowley, Moses and Waddell are relied on for teaching a prying angle between 65 and 85 degrees only. Sutton and Thomas are relied on for teaching a nonelongate device having a constant width along its length.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge


MURRIEL E. CRAWFORD
Administrative Patent Judge

Anton W. Fetting
ANTON W. FETTING
Administrative Patent Judge

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